

PATENT
W&B Ref. No. : INF 2127-US
Atty. Dkt. No. INFN/WB0053

REMARKS

This is intended as a full and complete response to the Restriction Requirement dated February 18, 2005, having a shortened statutory period for response set to expire on March 18, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-22 stand restricted under 35 U.S.C. 121 as follows:

- Group I Claims 1-13, drawn to an integrated test circuit in an integrated circuit for testing a plurality of internal voltages, classified in class 324, subclass 763.
- Group II Claims 14-22, drawn to a method of testing an integrated circuit using an on-board test circuit integrated within an integrated circuit, classified in class 324, subclass 763.

The Examiner states that:

"The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the apparatus can be used to practice a plurality of methods as disclosed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper."

Applicants provisionally elect Group I (claims 1-13) with traverse. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent; and (B) There must be a serious burden on the examiner if restriction is required. (MPEP § 803). Applicants respectfully submit that the Examiner has not met the criteria set above for a proper requirement for restriction.

First, Applicants respectfully submit that the Examiner has not established that the inventions are distinct because the Examiner has not shown that the product as claimed can be used in a materially different process. The burden is on the examiner to provide an example of a materially different process. (MPEP § 806.05(h)). However,

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the Examiner only states that "the apparatus can be used to practice a plurality of methods as disclosed." No example was given for a materially different process. Therefore, Applicants submit that the Examiner has not properly established that inventions are distinct.

Furthermore, Applicants respectfully submit that the Examiner has not established that there will be a serious burden on the examiner if restriction is required. The Examiner states that the inventions have "acquired a separate status in the art because of their divergent subject matter." However, MPEP § 808.02 states that separate status in the art "may be shown by citing patents which are evidence of such separate status, and also of a separate field of search." Applicants respectfully submit that the Examiner has not satisfied this criteria because the Examiner has not cited any patent as evidence of such separate status or field of search.

Therefore, Applicants submit that the examiner has not met either criteria for a proper restriction requirement. Withdrawal of the restriction requirement is respectfully requested.

The Examiner further restricts the claims between the species of Figure 1 and the species of Figure 2 and states that "it is not clear that any claim is generic". Applicants provisionally elect the species of Figure 2 with traverse. Applicants submit that claims 1-6 and 14-17 relate to the species of Figure 1 and that claims 7-14 and 18-22 relate to the species of Figure 2. Thus, it is clear that the independent method claim (claim 14) represents a generic claim for both species identified by the Examiner.

MPEP 806.04(e) states that:

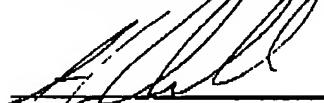
"Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP § 806.05 - § 806.05(i). If restriction is improper under either practice, it should not be required."

Applicants respectfully submit that Examiner has not shown that restriction is proper under both restriction practices for these related claims. Thus, withdrawal of this requirement is respectfully requested.

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Having addressed all issues set out in the Restriction Requirement, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Gero G. McClellan
Registration No. 44,227
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants

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